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In re Application of  
SMITH, et al.  
Serial No.: 10/575,117  
PCT No.: PCT/GB04/04328  
Int. Filing Date: 11 October 2004  
Priority Date: 09 October 2003  
Atty Docket No.: 317400017  
For: EXTENDIBLE MAST

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to applicant's petition under 37 C.F.R. § 1.47 filed 01 October 2007 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of joint inventor Alan Smith.

### **BACKGROUND**

On 11 October 2004, applicant filed international application PCT/GB04/04328 which claimed priority to an earlier application filed 09 October 2003. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 21 April 2005. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 09 April 2006.

On 07 April 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a first preliminary amendment.

On 01 March 2007, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 01 October 2007, applicant filed the present petition under 37 CFR 1.47(a) accompanied by payment of a five-month extension of time fee of \$1080.00. With the filing of the petition for a five-month extension of time and payment of the appropriate extension of time fee, the present petition is considered timely filed.

### DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1, 3 and 4.

Regarding item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature."

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47... The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as Internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should include a statement of facts. It is important that the statement contain facts as opposed to conclusions.

In support of the petition applicant has included documentation detailing the difficulty in locating Mr. Smith, but nothing on the actual presentation of papers to the inventor nor any information of attempts to locate a current mailing address for Mr. Smith. As such, it is not possible to grant applicant's petition at this time. As shown above, before an applicant can proceed pursuant to 37 CFR 1.47(a), the applicant must show that a diligent effort was made to locate the non-signing inventor. Applicant's present petition does not contain any firsthand account of attempts to locate Mr. Smith nor copies of documentary evidence to support the contention.

**CONCLUSION**

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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